

REMARKS

Applicants have carefully considered the November 1, 2007 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-14, 16, 17, 19 and 20 were pending in this application.

In response to the Office Action dated November 1, 2007, claims 3 and 5-10 have been canceled and claims 1 and 2 have been amended. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones et al. (U.S. Pat. App. Pub. No. 2004/0153408, hereinafter “Jones I”) in view of Lute, Jr. et al. (U.S. Pat. No. 7,222,782, hereinafter “Lute”) and further in view of Jones et al. (U.S. Pat. No. 7,187,795, hereinafter “Jones II”). Applicants respectfully traverse.

The present claimed subject matter, as described in each of independent claims 1, 11, 12 and 13, recites a banknote handling device comprising, inter alia, a counterfeit processing module that stores each banknote determined as counterfeit into the counterfeit collection box and prohibits the stored counterfeit banknote from being returned to the customer. The independent claims further require a notification module that notifies the customer of predetermined kind of information. The information provided for the customer, in the

notification, is indicative of a total amount of money received from the customer and is indicative of an amount of money settled as a transaction; regardless of the result of the counterfeit detection by the discrimination module.

Thus, the two features of the present claimed subject matter are summarized as follows: (a) a counterfeit banknote is recovered into a counterfeit collection box and is prohibited from being returned to a customer; and (b) the customer is notified of information for specifying a total amount of money received from the customer, including any received counterfeit banknotes. Moreover, claim 1 has been further amended to specify that the customer is notified of information for specifying an amount of money in banknotes determined as counterfeit by the discrimination module, out of the total amount of money received from the customer.

As conceded by the Examiner, Jones I and Lute fail to disclose that the customer is notified of information for specifying a total amount of money received from the customer, including any received counterfeit banknotes. The Examiner relied on Jones II, at col. 26, line 61 through col. 27, line 2, in an attempt to remedy the deficiency of Jones I and Lute. Applicants disagree with the Examiner's characterization of Jones II.

Jones II, at col. 26, line 61 through col. 27, line 2 is only describing step 1970 of Fig. 19a. Applicants note that the description of Fig. 19a begins at col. 26, line 25. Applicants note that Jones II, at col. 26, line 25-60, describes how the scanning system operates. Specifically, the ATM inspects the deposited bills to see if they have a serial number matching a counterfeit number, and when it is determined that none of the bills have such a serial number, they are transported to Bank A for further verification and routing through the Federal Reserve Bank system (step 1910). During the further verification, a counterfeit may be discovered (step 1920). To be more specific, if a counterfeit is discovered during further verification of the bills

transported to Bank A, the customer's account is debited for the amount of the counterfeit bill at steps 1950 and 1960, and then the serial number of the counterfeit bill is input to the database.

The present claimed banknote handling device notifies the customer of information for specifying a total amount of money received from the customer, including any received counterfeit banknotes. Jones II focuses in on a case where a counterfeit is discovered when bills including the counterfeit are transported to a bank and further verified. Jones II does not address the situation where a counterfeit is discovered at an ATM (banknote handling device).

In conclusion, Jones II fails to disclose that the customer is notified of information for specifying a total amount of money received from the customer, including any received counterfeit banknotes, as recited in each of independent claims 1, 11, 12 and 13, much less the added limitation to independent claim 1 which further specifies that the customer is notified of information for specifying an amount of money in banknotes determined as counterfeit by the discrimination module, out of the total amount of money received from the customer.

Each of independent claims 1 and 11-13 requires that the customer is notified of the total amount of money, which includes any counterfeit notes received from the customer as well as genuine notes. As described in the specification, the customer is notified of the amount of received counterfeit banknotes, as well as genuine banknotes, otherwise, the customer would be confused by a display that indicates a total amount of received genuine banknotes, especially since the devices of the present claimed subject matter do not return the counterfeit banknotes.

In view of the foregoing, Applicants submit that even if the applied references are combined as suggested by the Examiner, the subject matter of independent claims 1 and 11-13 will not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). The rejection should therefore be withdrawn.

Claims 16, 17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Edin et al. (U.S. Pat. No. 4,736,852, hereinafter “Edin”) in view of Lute and further in view of Jones II. Applicants respectfully traverse.

Independent claim 16 describes a banknote handling device including a management module that manages customer information for identifying each customer who handles a transaction, mapped to presence or absence of any counterfeit banknote involved in the transaction.

As conceded by the Examiner, Edin and Lute fail to disclose the management module of claim 16. The Examiner relied on Jones II, at col. 7, lines 3-59, in an attempt to remedy the deficiency of Edin and Lute. Applicants disagree with the Examiner’s characterization of Jones II. Applicants submit that Jones II does not teach the claimed management module at col. 7, lines 3-59. Specifically, Jones II, at col. 7, lines 3-30, describes that the scanning device obtains a customer identification number so as to enable the customer to make a deposit. Further, Jones II, at col. 7, lines 31-59, describes comparing the serial number of the deposited bill to a list of the serial numbers of counterfeit bills to see if a match is found. The currency bill found to be a counterfeit is flagged, and an indication of the suspected counterfeit bill is provided to the customer and operator of the system. In the section of column 7, lines 3-59 referred to by the Examiner, however, Jones II does not remotely disclose or suggest a management module for managing the customer information regarding a customer handling a transaction and mapping a counterfeit banknote to the customer. Thus, even if the applied references are combined as suggested by the Examiner, the subject matter of claim 16 will not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). The rejection should therefore be withdrawn.

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Edin in view of Jones II and further in view of Ikuta (U.S. Pat. No. 6,749,053, hereinafter “Ikuta”). Applicants respectfully traverse.

Claim 19 specifies that the collection box which stores counterfeit banknotes is located outside the safe. The Examiner admitted that neither Edin nor Jones II discloses this feature of claim 19. The Examiner asserted that Ikuta teaches this feature by referencing collection box 13, as shown in Fig. 2 of Ikuta. However, Applicants disagree with the Examiner’s characterization of the Ikuta reference. Ikuta discloses, at col. 7, lines 22-26, that if a banknote is judged to be normal it is stored temporarily in collection box 13, and if the banknote is judged to be counterfeit or not normal, it is sent back to the refunding portion 9 and so a counterfeit or a not normal banknote is returned to the customer. It should be clear that Ikuta does not teach or suggest the features of Claim 19 requiring that the counterfeit banknotes are not returned to the customer, and that the collection box for storing the counterfeit banknotes is located outside the safe. The rejection is not legally viable for at least this reason and should therefore be withdrawn.

Moreover, the Examiner asserts that Edin discloses the feature of not returning counterfeit banknotes to the customer. Applicants respectfully disagree. Edin describes “the return of rejected or non-acceptable documents to the outfeed or withdrawal opening of the apparatus” at column 5, lines 29-31. Thus, Edin is totally different from the claimed feature of claim 19, which requires that the counterfeit banknotes are not returned to the customer.

Independent claim 19 further describes that the banknote handling device includes a management module that manages customer information for identifying each customer who handles a transaction, mapped to the presence or absence of any counterfeit banknote involved in the transaction, wherein the management module maps each banknote involved in the transaction

to the customer information. Edin does not disclose that the customer ID number is mapped to each banknote, but rather, Edin only relates the customer ID to the amount of the deposit by the customer.

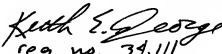
Accordingly, the rejection of claim 19 is not legally viable for the foregoing reasons and should be withdrawn.

It is believed that the pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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